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10/611,962	07/03/2003	Hiroshi Inoue	0054-0277P	3566

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EXAMINER	
SMARTH, GERALD A	

ART UNIT	PAPER NUMBER
2446	

NOTIFICATION DATE	DELIVERY MODE
11/17/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No.	Applicant(s)	
	10/611,962	INOUE ET AL.	
	Examiner	Art Unit	
	GERALD SMARTH	2446	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10/16/2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6, and 11-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6 and 11-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *03 July 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *11/10/2008*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. It is hereby acknowledged that 10/611962 the following papers have been received and placed of record in the file: Remark date 08/26/2008.

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/16/08 has been entered.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-3, 11 & 12 are being rejected under 35 U.S.C. 103(a) as being unpatentable over Iwase (US 2002/0046247A1) in view of Watanabe (6877031) ,

Regarding claim 1, Iwase teaches a print service system comprising: electronic mail receiving means connected with a network, for image data receiving an electronic mail including attached transmitted from a user through the network; **(Iwase discloses FIG. 6 is a diagram showing an example of the construction of a mail information database; FIG. 7 is a diagram showing an example of the construction of a storage destination specifying database; Paragraph 23 & paragraph 24)** Print user designation managing means ~~for making~~ which creates a user ID and a password and a directory for a mail address used by said user, and transmitting said user ID and said password to said mail address; data accumulating means for storing image data received by said electronic mail receiving means for each user ID in said directory; and at least one print means connected with the network, for downloading said image data from said data accumulating means through the network when said user ID and said password are inputted, and printing said image data." *(This is being anticipated by Iwase. Iwase discloses an electronic mail function is provided as one of the functions provided by the groupware server 2. That is, the groupware server is utilized by a personal computer or work station connected o the network." page 2 paragraph 44). (Iwase also discloses he also claims, in the item of the password, a password given to the user is recorded. In the item of the user ID, a user ID given to the user is recorded. The user ID may be the same as the account name or may be*

different from the account name; page 4 paragraph 70). Thus, communication traffic for transmitting the attached file to the portable telephone can be saved and the contents of the attached file can be stored so as to be utilized by the user; page 5 paragraph 110). (First, the user inputs a user ID and password by operating the touch panel 43a and operating panel 44 when the attached file stored in the Internet binder 3 is printed by use of the MFP4.; page 6 paragraph 115)

Iwase does not specifically disclose managing means which creates a user ID and a password and a directory for a mail address used by said user, and transmitting said user ID and said password to said mail address;

Watanabe does teach managing means which creates a user ID and a password and a directory for a mail address used by said user, and transmitting said user ID and said password to said mail address;**(Fig.3)** ***(Wantanabe discloses the WWW application server 15 compares the user ID and the user password having been input with a user ID and a user password registered with and managed by a user information database (not shown). When the user ID and the user password input by the user are valid, a main menu is shown on a screen. When the user selects an electronic mail transmission option from the main menu, the electronic mail transmission service which will be explained below is provided; Column 7 lines 29-36)***

It would be obvious to a person of ordinary skill in the art at the time of the invention to modify the communication system of Iwase to include Watanabe's network photograph service system. One of ordinary skill would have been motivated to make

this modification in order to have an system which can transmit images to different destinations in a more time efficient and cost effective manner. This will allow for the user to specifically create his or her unique username and password to be associated with emails being designated for him or her. This will be useful for creating user security of an individual's personal information content being stored on a server for example. *Watanabe discloses however, it is time-consuming for the user to obtain a recording medium such as a CD-ROM after placing an order for a service to output an image to the recording medium. It is possible to request the service to output images to a recording medium upon requesting image registration. However, in this case, since the image that is desired to be attached to an electronic mail message is not determined at the dine of the request for image registration, all the images end up being recorded, which is costly; Column 1 lines 35-46.*

Therefore, it would be obvious to combine Iwase and Watanabe to arrive to the limitations in claim 1.

Regarding Claim 2 Iwase in view of Watanabe taught a print service system according to claim I, as described above. Iwase also teaches further comprising usage guide displaying means connected with the network, for displaying a usage guide including information related to an installation location of said print means.

*(**Iwase anticipates this by disclosing Fig.19 is a diagram showing a display example in which the file list received from the Internet binder 3 is displayed on the display section 43. In this case, a file can be selected by touching the file***

displayed on the display section 43 of the touch panel 43a. In the display example shown in FIG. 19, the above file selection screen is display section 43." ;page 6 paragraph 120)

Regarding claim 3 Iwase in view of Watanabe taught a print service system according to claim 1, as described above. Iwase further teaches wherein: said print means includes a touch panel; and said user ID and said password are inputted from an input unit composed of a ten-key pad which is displayed on said touch panel. ***(Iwase anticipates this by disclosing Fig 14. is a diagram showing a display example when a mail is received from the portable telephone 1 and log-in (access) is made from the portable telephone 1 to the groupware server 2. In the display example of Fg. 14, a user ID input column and a password input column are displayed." page 5 paragraph 100. Iwase further discloses the display section 43 is a display constructed by a liquid crystal display device containing a touch panel 43a;Page 3 paragraph 63 line 6-8)***

Regarding claim 11, Based on the same motivation as in claim 1, Iwase and Watanabe teach a print service program for causing a computer connected through a network with a print terminal which performs authentication using a user ID and prints designated image data, to execute: an electronic mail reception step for receiving an electronic mail including attached image data transmitted from a user through the network; **(Iwase discloses in the item of the password, a password given to the user is recorded.**

In the item of the user ID, a user ID given to the user is recorded. The user ID may be the same as the account name or may be different from the account name; page 4 paragraph 70. The MFP4 transits the user ID and password and effects a process for connection to the Internet binder 3. If connection to the Internet binder 3. If connection with the MFP 4 is made, the Internet binder 3 transmits a stored list of files corresponding to the user ID transmitted from the MFP 4 to the MFP 4; Page 6 Paragraph 118) a user ID creation step for creating a user ID for a mail address used by the user; a user ID transmission step for transmitting the user ID to the mail address; and a data accumulation step for storing the attached image data for each user ID. **(Fig.3)** ***(Wantanabe discloses the WWW application server 15 compares the user ID and the user password having been input with a user ID and a user password registered with and managed by a user information database (not shown). When the user ID and the user password input by the user are valid, a main menu is shown on a screen. When the user selects an electronic mail transmission option from the main menu, the electronic mail transmission service which will be explained below is provided; Column 7 lines 29-36)***

Regarding claim 12, Based on the same motivation as in claim 1, Iwase and Watanabe teach a print service program for causing a computer connected through a network with a print terminal which performs authentication using a user ID and prints designated image data, to execute: an electronic mail reception step for receiving an electronic mail including attached image data transmitted from a user through the network; **(Iwase**

discloses in the item of the password, a password given to the user is recorded. In the item of the user ID, a user ID given to the user is recorded. The user ID may be the same as the account name or may be different from the account name; page 4 paragraph 70. Iwase further discloses the MFP4 transits the user ID and password and effects a process for connection to the Internet binder 3. If connection to the Internet binder 3. If connection with the MFP 4 is made, the Internet binder 3 transmits a stored list of files corresponding to the user ID transmitted from the MFP 4 to the MFP 4; page 6 paragraph 118) a user ID creation step for creating a user ID for one of the attached image data and the electronic mail; a user ID transmission step for transmitting the user ID to a mail address used by the user; and a data accumulation step for storing the attached image data for each user ID. **(Fig.3)** ***(Wantanabe discloses the WWW application server 15 compares the user ID and the user password having been input with a user ID and a user password registered with and managed by a user information database (not shown). When the user ID and the user password input by the user are valid, a main menu is shown on a screen. When the user selects an electronic mail transmission option from the main menu, the electronic mail transmission service which will be explained below is provided; Column 7 lines 29-36)***

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 4-6, 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwase(2002/0046247) , Watanabe(6877031) in further view of Petrogiannis (2002/0078159),

Claim 4 states, Iwase in view of Watanable a taught a print service system according to claim 1, as disclosed above. Wherein when a mail address of a third party is described in a body of the electronic mail received by said electronic mail receiving means, said user designation managing means transmits a user ID and a password to said mail address of the another user simultaneously with transmitting said user ID and said password to said mail address of the user." **(Fig.3)** ***(Wantanabe discloses the WWW application server 15 compares the user ID and the user password having been input with a user ID and a user password registered with and managed by a user information database (not shown). When the user ID and the user password input by the user are valid, a main menu is shown on a screen. When the user selects an electronic mail transmission option from the main menu, the electronic mail transmission service which will be explained below is provided; Column 7***

lines 29-36) (Iwase discloses an electronic mail function is provided as one of the functions provided by the groupware server 2. That is, the groupware server is utilized by a personal computer or work station connected o the network. (page 2 paragraph 44). He also claims, in the item of the password, a password given to the user is recorded. In the item of the user ID, a user ID given to the user is recorded. The user ID may be the same as the account name or may be different from the account name; page 4 paragraph 70). Thus, communication traffic for transmitting the attached file to the portable telephone can be saved and the contents of the attached file can be stored so as to be utilized by the user (page 5 paragraph 110). First, the user inputs a user ID and password by operating the touch panel 43a and operating panel 44 when the attached file stored in the Internet binder 3 is printed by use of the MFP4. Iwase doesn't teach "wherein when a mail address of another user except said user is described in a body of the electronic mail received by said electronic mail receiving means, said user designation managing means transmits a user ID and a password to said mail address of the another user simultaneously with transmitting said user ID and said password to said mail address of the user."

Petrogiannis teaches sending the address of other users for access to attachment via user id and password. ***Petrogiannis states "The present invention also provides a method for a proponent to enable the secure approval of at least one electronic document by a plurality of correspondents over a network, each correspondent having a correspondent terminal connected to the network."***

(page 1 paragraph 18) "The correspondent logs in by entering the user ID and password that was included in the body of the e-mail message." (page 6 paragraph 100) "The plug-in queries the enrollment engine at the proponent server to obtain a user ID and password for that particular correspondent's enrollment, defining the enrollment information. This information is then inserted into the e-mail by the client plug-in of the proponent along with a URL to the enrollment page, and attaches the document to the e-mail. The e-mail with the enrollment information and the attached document is then sent to the correspondent. "(page 6 paragraph 125 line 11) Petrogiannis is for teaching that multiple users having access to an attachment using a user specific user id and password via email.

It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to modify emails with user Id and password protected attachments as being taught by Iwase, and Watanabe's network photograph service system to show multiple users can have access to this or these attachments in emails by using a user id and password which was given through a server and was specified by another user via email as stated by Petrogiannis. One of ordinary skill would have been motivated to make this modification in order to have email system of Iwase which utilizes a username and password to include a method for a third party is described in a body of the electronic mail received by said electronic mail receiving means, said user designation managing means transmits a user ID and a password to said mail address of the another user simultaneously with transmitting said user ID and said password to said

mail address of the user. This will allow for multiple users to receive the user ID and password. This will be useful for creating user security of an individual's personal information more efficiently.

Therefore, it would be obvious to combine Iwase, Watanabe and Petrogiannis to arrive to the limitations of claim 4.

Regarding claim 5, Iwase, Watanabe in view of Petrogiannis taught a print service system according to claim 4, as described above. Petrogiannis further teaches where in said user ID and said password which are transmitted to said mail address of said third party said are identical to said user ID and said password which are transmitted to said user's mail address." ***(Petrogiannis discloses (i) transmitting a user ID and password to the correspondent terminal; (ii)accessing the proponent server from the correspondent terminal using this user ID and password; Page 4 paragraph 62, & 63.)***

Regarding claim 6, Iwase, Watanabe in view of Petrogiannis taught a print service system according to claim 4, as described above. Petrogiannis further teaches wherein said user ID and said password which are transmitted to said mail address of said third party are different from said user ID and said password which are transmitted to said user's mail address." ***(Petrogiannis discloses (i) transmitting a user ID and password to the correspondent terminal; (ii)accessing the proponent server from***

the correspondent terminal using this user ID and password; Page 4 paragraph 62, & 63.) **(Fig.3)**

Regarding claim 13, Based on the same motivation as in claim 4, Iwase, Watanabe in view of Petrogiannis teaches a print service program for causing a computer connected through a network with a print terminal which performs authentication using a user ID and prints designated image data, to execute: (***Iwase discloses an electronic mail function is provided as one of the functions provided by the groupware server 2. That is, the groupware server is utilized by a personal computer or work station connected o the network. (page 2 paragraph 44). He also claims, in the item of the password, a password given to the user is recorded. In the item of the user ID, a user ID given to the user is recorded. The user ID may be the same as the account name or may be different from the account name; page 4 paragraph 70).***

an electronic mail reception step for receiving an electronic mail including attached image data transmitted from a user through the network; a judgment step for judging whether or not a mail address of ~~another user except the user is~~ third party described in a body of the electronic mail received; a user ID creation step for ~~making~~ creating a user ID and a password for a mail address used by the user and the mail address of the ~~other user~~ ~~third party~~ when it is judged that the mail address of the ~~other user~~ third party is described in said judgment step; a user ID transmission step for transmitting the user ID and the password which are made in the user ID creation step to the mail

address of the user and the mail address of the ~~other user~~ third party; **(Fig.3)** ***(Wantanabe discloses the WWW application server 15 compares the user ID and the user password having been input with a user ID and a user password registered with and managed by a user information database (not shown). When the user ID and the user password input by the user are valid, a main menu is shown on a screen. When the user selects an electronic mail transmission option from the main menu, the electronic mail transmission service which will be explained below is provided; Column 7 lines 29-36)*** and a data accumulation step for storing the attached image data for each user ID. "

(Petrogiannis discloses the present invention also provides a method for a proponent to enable the secure approval of at least one electronic document by a plurality of correspondents over a network, each correspondent having a correspondent terminal connected to the network; page 1 paragraph 18. Petrogiannis also states there is a so provided in accordance with yet another aspect of the present invention a system for a proponent to enable the secure approval of an electronic document by a correspondent over a network, this system including: page 2 paragraph 27. A server application provided on a proponent server connected to the network, the server application comprising approval tools for the secure approval of the electronic document; page 2 paragraph 28. Transmitting the electronic document from the propend server to a correspondent terminal connected to the network; and page 2 paragraph 29. A correspondent application provided on the correspondent application allowing

the correspondent to remotely access the approval tools on the proponent server through the network from the correspondent terminal, and approving the electronic document on the correspondent terminal using the approval tools accessed by the correspondent application." page 2 paragraph 30)

Regarding claim 14, Iwase, Watanabe in view of Petrogiannis taught a print service program according to claim 13, as described above. Petrogiannis further teaches wherein the user ID and the password which are transmitted to the mail address of the other user are identical to the user ID and the password which are transmitted to the mail address of the user." Transmitting identical user ID and the password to said user mail address and of other user mail address is considered inherent for sending out the same user ID and password to multiple users. ***(Petrogiannis discloses (i) transmitting a user ID and password to the correspondent terminal; (ii)accessing the proponent server from the correspondent terminal using this user ID and password; Page 4 paragraph 62, & 63.)*** This can be interpreted as giving multiple users the same access.

Regarding claim 15, Iwase, Watanabe in view of Petrogiannis taught a print service program according to claim 13, as described above. Petrogiannis further teaches wherein the user ID and the password which are transmitted to the mail address of the other user are different from the user ID and the password which are transmitted to the mail address of the user." ***(Petrogiannis discloses (i) transmitting***

a user ID and password to the correspondent terminal; (ii)accessing the proponent server from the correspondent terminal using this user ID and password; Page 4 paragraph 62, & 63.) This can be interpreted as giving multiple users the different access.

Response to Argument

7. Applicant's arguments with respect to claims 1-6, and 11-15 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. The following prior art made of record and not relied upon is cited to establish the level of skill in the applicant's art and those arts considered reasonably pertinent to applicant's disclosure. See MPEP 707.05 ©.

9. The following reference teaches execution of trial data.

US 2001/6240089

US 2003/6611872

US 2000/6092220

US 2002/6389475

US 1992/5095480

The examiner requests, in response to this Office action, support be shown for language added to any original claims on amendment and any new claim. That is indicated support for newly added claim language by specifically pointing to page(s) and line no(s) in the specification and/or drawing figure(s). This will assist the examiner in prosecuting the application.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Smarth whose telephone number is (571)270-1923. The examiner can normally be reached on Monday-Friday(7:30am-5:00pm)est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Pwu can be reached on (571)272-6798. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. S./

Examiner, Art Unit 2446

/Jeffrey Pwu/

Supervisory Patent Examiner, Art Unit 2446